

**REMARKS**

The Office Action of September 17, 2008 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested. Claims 12, 20 and 22 have been amended. New claims 24 – 27, dependent from claims 20 or 22, have been added to set forth further limitations of the methods.

Turning now, to the office action, Applicants appreciate the Examiner's indication that claims 1, 3-10 and 13 are allowed.

Claim 12 is objected to as depending from a cancelled claim. Claims 20 – 23 were rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (US 6,033,146; hereinafter "Shaw") in view of Harvey (US 6,568,146) and Danielson (US 4,281,496).

Relative to the objection to claim 12, the claim has been amended herein to depend from allowed claim 1. Accordingly, amended claim 12 is also believed to be in condition for allowance.

Considering the rejection of claims 20 – 23 under 35 USC §103(a) as being unpatentable over Shaw in view of Harvey and Danielson, Applicants respectfully traverse the rejection in light of the amendments set forth herein.

The disclosures of the cited art and the distinctions between amended claims 20 and 22 may be briefly summarized as follows:

Shaw, directed to "GLASS CHIP LITHOCRETE AND METHOD OF USE OF SAME," is alleged to teach several of the operations set forth in method claims 20 and 22, including partial curing of concrete with integrated aggregate, washing and brushing of the surface to remove no more than five percent of the particulates and then fully curing and washing before undergoing additional grinding and polishing.

Shaw, apparently building upon a prior patent, discloses a surface-seeded, exposed particulate concrete. Relative to surface seeding/exposure, Shaw teaches at col. 1, lines 22-48, that the exposure of aggregate leads to surface roughness when large aggregate is used and precludes use of the technique in flooring (see e.g., col. 1, lines 32-34). Such a statement establishes that Shaw's exposure of particulate

arises through the removal of cement material alone to expose the upper surface of the particulate, and not by removing an upper portion of the particulate, as there would be no resulting roughness or texture if the cement and particulate were removed uniformly. Such an interpretation is further supported by Shaw, stating:

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### SUMMARY OF THE INVENTION

30 The present invention specifically addresses and alleviates the above-mentioned deficiencies associated with the prior art. Generally, the present invention comprises a surface seeded exposed particulate concrete and method of producing the same, which utilizes small, potentially reactive particulates, preferably glass, organic materials such as seashells, metals, composite materials and the like, characterized by having an average mean diameter of approximately less than three-eighths of an inch and a generally rounded or angled exterior, which is permanently adhered to the surface of the concrete to provide a flat, smooth textured concrete surface. The resulting surface is extremely suitable for pedestrian high traffic flow applications. The resultant

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(Shaw; col. 2, lines 25-39; underlining added)

Similarly, an indication that the amount of material used impacts the “finish” (col. 4, lines 10-13) suggests that the particulate is not being removed, but that the top surface of the particulate is merely being exposed or revealed as further taught at col. 4, lines 41-46). In other words, Shaw teaches that the particulate exposure does not remove the particulate material itself (no more than 5%; col. 4, lines 49), but exposes the top surface of such particulate.

Shaw intends for the particulate to be exposed using non-grinding steps (water, sponge, broom; col. 4, lines 44-49) to produce a textured surface. Thus, Shaw teaches away from grinding of the particulate in partially cured concrete. While Shaw does disclose methods “to create texture variations on the surface” (col. 4, lines 60-65), Applicants respectfully maintain that such teachings do not give rise to or suggest the presently recited limitations of “... grinding the upper surface of the partially cured concrete with the integrated aggregate therein, including removing a generally uniform layer including some of both the partially cured concrete and the integrated aggregate material at least until the remaining aggregate is exposed uniformly over the top of the concrete,” as set forth in amended claim 20, for example.

The rejection also relies upon Harvey and Danielsson in combination with Shaw. Applicants note that Harvey teaches away from the claimed invention, and Shaw as well. Harvey is directed to producing a finished floor surface that is poured in place over an existing subfloor (col. 2, lines 39-43) by preparing a self-leveling topping consisting of cementous-based fine topping. Thus, Harvey teaches away from forming an integrated ornamental surface on a monolithic concrete floor, and is not an analogous method as has been alleged by the Examiner. Furthermore, the additional steps required for the decorative surface taught by Harvey would require secondary processes and additional costs, as compared to Shaw or the methods of the rejected claims, further indicating that it would not have been obvious to make the proposed combination.

Applicants respectfully maintain that Harvey does not expressly teach grinding to remove a layer of generally uniform thickness from the upper surface, thereby removing some of both the partially cured concrete and the integrated aggregate material. Nor is it clear where Harvey teaches use of a rotary head concrete grinding machine, as set forth in claim 22, to remove a uniform layer of some of both the partially cured concrete and integrated aggregate material.

Danielsson expressly teaches away from the use of troweling or finishing of the concrete (col. 3, lines 30-35; col. 7, lines 55-65) as taught by Shaw and uses the process of grinding following floating to produce a "flat porous surface having a sanded characteristic" (col. 6, lines 50-52; col. 8, lines 8-10; col. 9, lines 30-32). Danielsson also does not teach grinding to achieve uniformly exposed aggregate as required by the rejected claims. Rather, Danielsson consistently teaches grinding to produce a surface with a sanded quality.

Applicants respectfully remind the Examiner that Danielsson is not directed to providing an exposed surface flooring, but a subfloor upon which "tile, carpeting or the like" may be applied (see object of the invention at col. 5, lines 53-55). Applicants further submit that the teachings of the densification operation of Danielsson clearly establish that densification is employed to produce an upper layer of sand, concrete and water (col. 7, lines 38-40) that lacks aggregate, such that a thin surface layer (col. 8, lines 7-9) can be removed to "produce a flat, porous surface having a sanded quality..." (col. 8, lines 8-10). Not only does Danielsson not teach the removal of aggregate in the grinding operation, it specifically teaches

densification to assure the upper layer to be substantially free of the aggregate. Applicants urge this is contrary to the teachings of Shaw, and to the limitations set forth in the rejected independent claims.

In view of the contrary teachings of Shaw, Harvey and Danielsson, and absent a showing of how the teachings of the patents can be combined to describe all of the limitations of the rejected independent claims, *prima facie* obviousness has not been established. In particular, Applicants respectfully urge that the Examiner's stated basis for combination ("... modified the method of Shaw et al. and to have ground the partially cured concrete floor containing decorative aggregates, thereby partially removing some of the concrete and aggregate, as suggested by Danielsson and Harvey"; Office Action page 4) is incorrect, and thus cannot support the combination or the interpretation of the teachings in the cited patents.

Considering, *in arguendo*, a combination of Shaw, Harvey and Danielsson, Applicants respectfully believe that all fail to teach or suggest the recited limitation of grinding the upper surface of a partially cured concrete removing a generally uniform layer including some of the integrated aggregate therein until the aggregate is exposed uniformly over the top of the concrete. Applicants hereby traverse the rejection based upon the arguable combination of Shaw in view of Harvey and Danielsson.

Insofar as claims 21 and 23 are concerned, these claims all depend from now presumably allowable amended claims 20 or 22, respectively, and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to claim

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

/Duane C. Basch, Esq. Reg. No. 34,545/

Duane C. Basch

Attorney for Applicant

Registration No. 34,545

Basch & Nickerson LLP

1777 Penfield Road

Penfield, New York 14526

(585) 899-3970

DCB/dcm